REMARKS

Upon entry of the present amendment, claims 1-8 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, the amendments made to claims 1 and 2 find support in Examples 38-40 (at page 41, line 11 to page 43, line 3 of the specification). As such the amendment made herein to the claims does *not* incorporate new matter into the Application as originally filed.

It is submitted that entry of the instant amendment after final rejection is entirely appropriate, as the amendment removes and/or simplifies issues for appeal and /or serves to put the case in immediate condition for allowance, and requires no further search or consideration on the Examiner's part.

Claim Rejections Under 35 USC § 102(b)/103(a)

Claims 1-8 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over YOUNG et al. (US 3,893,947). Reconsideration and withdrawal of this rejection is respectfully requested based upon the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the

prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Obviousness

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365,

1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

In the presently pending claims it is provided that the oxidation catalyst composition is obtained "as a homogeneous solution" *(see claim 1)*, or comprises a composition that is obtained "as a homogeneous solution" *(see claim 2)*. In this regard, the language "as a homogeneous solution" in each of claims 1-2, recites a property of the claimed catalyst composition, and is *not* merely the recitation of a process step.

In contrast, the cited Young et al. US '947 reference provides for a calcined catalyst, which is a solid and which is *not* the same as a "homogeneous solution" as instantly claimed.

As such, it is submitted that it is impossible for the disclosure of the cited Young et al. US '947 reference to either anticipate or render obvious the instant invention as claimed and recited in pending claims 1-8.

In support of the above contention, the cited Young et al. US '947 reference fails to teach or provide for each of the limitations recited in any one of pending claims 1-8, and therefore, those of ordinary skill in the art upon considering the disclosure of Young et al. US '947 would in *no* way be motivated to arrive at the present invention as claimed, after considering the teachings and disclosure of Young et al. US '947. Any contentions of the US PTO to the contrary must be reconsidered.

Accordingly, it is submitted that the outstanding anticipation and obviousness rejections based on the disclosure of Young et al. US '947 must be withdrawn at present.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-8 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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